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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,343	02/12/2004	Kyung-geun Lee	1793.1205	1758
49455 7590 11/26/2007 STEIN, MCEWEN & BUI, LLP 1400 EYE STREET, NW SUITE 300 WASHINGTON, DC 20005			EXAMINER PSITOS, ARISTOTELIS M	
			ART UNIT 2627	PAPER NUMBER
			MAIL DATE 11/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/776,343

Applicant(s)

LEE, KYUNG-GEUN

Examiner

Aristotelis M. Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/16/07 & 10/9/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submissions filed on 6/14/07 and 10/9/07 have been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-34 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of U.S. Patent No. 7009926. Although the conflicting claims are not identical, they are not patentably distinct from each other because obviously the method exists when the apparatus perform its function.

No further analysis is required.

Response to Arguments

Applicant's arguments filed 10/9/07 have been fully considered but they are not persuasive.

Applicants' arguments identify the acknowledged differences between the claimed subject matter in the above noted patent and the present claimed subject matter. As indicated above, such differences in claimed subject matter is acknowledged. However, no arguments have been presented as to the "obviousness" between the apparatus of the patent and the method of the present claims.

The rejections are maintained.

2. Claims 1,2,4-9,12 and 17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No 6934236. Although the conflicting claims are not identical, they are not patentably distinct from each other because

a) the structural difference in the present independent claim 1, i.e., the lead-in, lead-out and user data areas are inherently present in the above claims of the patent – see for instance claim 6 or 7.

With respect to claims 2,12 and 17, see patented claim 3.

With respect to claims 4 and 7, see patented claims 7 and 8.

With respect to claim 5, see patented claim 9.

With respect to claims 6 and 8, see patented claim 4 (push-pull is the difference).

With respect to claim 9, see patented claims 10 or 12.

The version number is the compatibility information.

Response to Arguments

3. Applicant's arguments filed 10/9/07 have been fully considered but they are not persuasive. In particular, the "obviousness" centers upon the terminology "version" and the compatibility information. The examiner maintains that the claimed terminology is an "obvious" variant of "version. Applicants' attention is further drawn to the above noted patent, see for instance the disclosure starting at col. 2, line 29 and continuing till col. 4 line 31.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1 and 33 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Ko ('054), ('493) or ('605) as analyzed below.

The applied references have a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 1 and 33 are drawn to a recording/reproducing method with respect to an information storage medium, wherein compatibility information is detected, and then transferring data to a drive in order to make it compatible with a newer version.

Any of the above noted Ko patents disclose – see the abstracts thereof – the ability of having compatibility information – newer version – contained in/on a recording medium so as to make the drive compatible to newer versions. See the discussion with respect to figures 4 and 5 of the above documents.

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Although there is no clear depiction of the lead-in, lead-out and user data area, the systems operate upon appropriately manufactured dvd discs and such physical areas, lead-in, lead-out and user data are inherently present.

If applicant can convince the examiner that such limitations are not inherently present, then under 103 considerations, the examiner relies upon the acknowledged prior art in this application that defines such.

It would have been obvious to modify the base system of Ko with such well-known record media, motivation is to use existing media in the above Ko systems and hence not require the manufacturing of non-standard discs.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are not persuasive. The examiner has interpreted the ability of the "version" identification.— see for instance the disclosure starting at col 3 line 37 and continuing till col. 4 line 11 - as an "obvious" variant of the claimed "compatibility information".

Claim Rejections - 35 USC § 103

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 and 33 above, and further in view of Tasaka et al.

The examiner interprets the information as designated in figure 3 with respect to either the recording speed/or the opc as indicative of the optimal writing pattern.

It would have been obvious to modify the base system as relied upon above with respect to claims 1 and 33 with the additional teaching from Tasaka et al, motivation is to provide for a transparent reproduction of information.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are maintained as argued above with respect to claim 1, i.e., claim 1 is still rejected.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of see Sasa et al ('595) starting at col. 8 line 39 with respect to the DVD Specification, July version 1.9 . The examiner does not have a copy thereof. If applicant has a copy handy, submission of such would be greatly appreciated.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but fall with parent claim

1.

7. Claims 4,5,6, 7,8, 12,13,14,15,16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of Lim.

With respect to the above claims, such a format is in existence already – see figure 5 of Lim for instance.

With respect to claims 6 and 8, such is interpreted as the summed rf signal at the output of the optical detectors in either the base references, or the system used in Lim.

It would have been obvious to modify the base system of Inazawa et al with the above teachings from Lim, motivation is to permit Inazawa et al recording capability to be compatible with Lim's recording capability, hence compatible.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but fall with parent claim

1.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 12 above, and further in view of Miyake et al.

Miyake et al discloses the ability of having information identifying velocity – which the examiner interprets as recording speed.

It would have been obvious to modify the base systems as relied above with respect to claim 12 and include the additional speed parameter – motivation is to permit a transparent operation upon rec/repr.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but fall with parent claim

1.

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9. Claims 18,19,20,21,22,23 are rejected under 35 U.S.C. 103(a) as being unpatentable over and of the Ko references ('054), ('493) or ('605) further considered with Miyake et al.

The Ko references are relied upon for the reasons stated above with the analysis of claim 1 and 33 – not the title and the abstract. The examiner concludes that these systems depict a disc having the lead in, lead out and data areas. Data is transferred accordingly.

There is no writing pattern clearly depicted, although there is modulation information.

Miyake et al teaches in this environment the ability of having writing strategies, ws1, ws2 appropriately located for the desired ability. This is interpreted as meeting the newly introduced limitations with respect to one of a multi-pulse and a single-pulse write strategy.

The sum signal is inherently present, i.e., the output of the optical detector elements.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but fall with their respective parent claim.

9. Claims 24,25,26,27, 28,29, 30, 31,32,34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ko, (references ('054), ('493) or ('605) further considered with Tasaka et al and all further considered with Miyake et al. The examiner is relying upon the US patent equivalent of such – patent 7068579 – as providing the English translation thereof.

The Ko references are relied upon for the reasons stated above with the analysis of claim 1 and 33 – not the title and the abstract. The examiner concludes that these systems depict a disc having the lead in, lead out and data areas. Data is transferred accordingly.

In Tasaka et al – see figure 3 with respect to the discussion of bp area depicts reserved areas As well as the writing speeds, and the OPC capability.

In Miyake et al – see the discussion with respect to figure 62 and the various positions within the read only and read able areas.

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The sum signal is inherently present, i.e., the output of the optical detector elements.

It would have been obvious to modify the base system of Ko with the above teachings from Tasaka et al and Miyake et al, motivation is to use existing disc having established formats thereon and hence save valuable resources such as designing new disc formats.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are not persuasive for the reasons stated above with respect to the argument(s) with respect to claim 1.

Errata

The subject matter of claim 2/1 and that of claim 18 are substantially duplicative of each other, as is the subject matter of claim 3/1 and claim 24. Further clarification is respectfully required, else if claims 2/1 and 3/1 are allowed, then the duplicate claims 18 and 24 will be objected to and require cancellation, see MPEP § 706.03 (k).

Applicants' have amended claim 1, line 5 to now read: "... to record and reproduce data ..". However, line1 of the claim still recites record and/or reproduce. These two lines appear to contradict each other. Further clarification is respectfully required.

Conclusion

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-F: 6:00 - 2:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aristotelis M Psitos
Primary Examiner
Art Unit 2627



AMP